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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,930	12/03/2003	Chiyoko Matsumi	MTS-3581US	4482

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EXAMINER	
DINH, TAN X	
ART UNIT	PAPER NUMBER
2627	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/725,930	MATSUMI ET AL.	
	Examiner	Art Unit	
	TAN X. DINH	2627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) _____ is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 6-19* is/are rejected.

7)☒ Claim(s) *2-5* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

1) The I.D.S filed 4/14/2004, 6/22/2005, 5/11/2006 and 9/11/2006 have been considered by the Examiner. However, the Japan and/or foreign document(s), if they have not been written in English, are considered to the extent that could be understood from the English Abstract and the drawings.

Form PTO-1449 or PTO/SB/08 is(are) attached herein.

2) The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The following title is suggested:

METHOD AND APPARATUS FOR REPRODUCING PLAYLIST IN CD-RW.

3) The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed TERMINAL DISCLAIMER in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A TERMINAL DISCLAIMER signed by the assignee must fully comply with 37 CFR 3.73(b).

4) Claims *1 and 8-13* are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims *5 and 7-9* of copending Application No. 11/090,544. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Claims *5 and 7-9* of copending Application No. 11/090,544 and claims *1 and 8-13* in this instant application recite the same feature with each other, such as, a recording and reproducing system comprises a record medium for holding a plurality of data files for storing predetermined data, play list recording means of recording a play list for describing reproduction order in which the predetermined data stored in all or a part of plurality of data files respectively is reproduced by using a unique data file ID given to each of data files in a play list file for storing play

list held in said record medium, data reproducing means of reproducing the predetermined data stored in all or a part of plurality of data files respectively by using said reproduction order based on recorded play list, with a little different in languages. However, this/these different is not a patentable weight since the body of these claims recite the same structures and/or functions with each other and this would not make them a patentable distinction.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5) Claims *1 and 8-13* are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims *1,7,10 and 12* of copending Application No. 10/725,940. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Claims *1,7,10 and 12* of copending Application No. 10/725,940 and claims *1 and 8-13* in this instant application recite the same feature with each other, such as, a recording and reproducing system comprises a record medium for holding a plurality of data files for storing predetermined data, play list recording means of recording a play list for describing reproduction order in which the

predetermined data stored in all or a part of plurality of data files respectively is reproduced by using a unique data file ID given to each of data files in a play list file for storing play list held in said record medium, data reproducing means of reproducing the predetermined data stored in all or a part of plurality of data files respectively by using said reproduction order based on recorded play list, with a little different in languages. However, this/these different is not a patentable weight since the body of these claims recite the same structures and/or functions with each other and this would not make them a patentable distinction.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6) Claims *14-19* are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims *14-19* are drawn to a "program" per se as recited in the preamble and as such are non-statutory subject matter. See MPEP § 2106.IV.B.1.a. Claims to processes that do nothing more than install a program in a computer or concepts are non-statutory. If the "acts" of a claimed process manipulate only numbers, abstract concepts or ideas, or signals representing any of the foregoing, the acts are

not being applied to appropriate subject matter. SCHRADER, 22 F.3d at 294-95, 30 USPQ2d at 1458-59. Thus, a process consisting solely of mathematical operations without some claimed practical application or does not manipulate appropriate subject matter are not constitute a statutory process. In this case, the claims merely recite " a program for causing .... " , which simply manipulates abstract ideas without some claimed practical application.

7) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> 8) (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> 9) (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10) Claims *1 and 6-13* are rejected under 35 U.S.C. 102(b) as being anticipated by HANCOCK (WO 03/41319 A2).

HANCOCK discloses a recording and reproducing system as claimed in claim 1, comprising:

a record medium for holding a plurality of data files for

storing predetermined data (specification, page 2. In this case, the recording medium is CD-R);

play list recording means of recording a play list for describing reproduction order in which the predetermined data stored in all or a part of said plurality of data files respectively is reproduced by using a unique data file ID given to each of data files in a play list file for storing play list held in record medium (Fig.12, play-list record area 1202; figure 4, play-list in sector lay-out. Figure 6, track number 602 is data file ID, see specification, page 18, lines 3-9. See also specification, page 15, lines 25-26; page 16, lines 4-6 and page 8, lines 3-25);

data reproducing means of reproducing the predetermined data stored in all or a part of plurality of data files respectively by using reproduction order based on recorded play list (In this case the reproduction of data files can be perform according to any desirable order and parameter specified in the play-list. See figure 6 and specification, page 18, lines 3-14).

As to claim 6, HANCOCK shows play-list describes reproduction order by using grouping (figures 5, 7 and 8).

As to claim 7, HANCOCK shows play-list describes reproduction order to be rewritable (specification, page 2).

Apparatus and method claims *8-13* are drawn to the apparatus/method corresponding to the recording and reproducing system of using same as claimed in claim 1. Therefore, apparatus/method claims *8-13* are rejected for the same reasons of anticipation as used above.

11) Claims *1 and 6-13* are further rejected under 35 U.S.C. 102(e) as being anticipated by NONAKA et al (6,614,732).

NONAKA et al discloses a recording and reproducing system as claimed in claim 1, comprising:

a record medium for holding a plurality of data files for storing predetermined data (Fig.1, CD 100);

play list recording means of recording a play list for describing reproduction order in which the predetermined data stored in all or a part of said plurality of data files respectively is reproduced by using a unique data file ID given to each of data files in a play list file for storing play list held in record medium (figures 9, 11a and 11b show the steps for recording a play-list in hard-disk 20. see also column 8, line 35 to column 10, line 15);

data reproducing means of reproducing the predetermined data stored in all or a part of plurality of data files respectively by using reproduction order based on recorded play list (In this case

the reproduction of data files can be perform according to any desirable order and parameter specified in the play-list. See figures 10a, 10b,11a and 11b).

As to claim 6, NONAKA et al shows play-list describes reproduction order by using grouping (figures 11a and 11b, the play-list can be grouping into POPS 1, CLASSIC 1, BEETHOVEN 1, BACH 1, etc.,).

As to claim 7, NONAKA et al shows play-list describes reproduction order to be rewritable (figures 10a, 10b, 11a and 11b. The play-lists can be rewritable since they have been recorded on hard-disk).

Apparatus and method claims *8-13* are drawn to the apparatus/method corresponding to the recording and reproducing system of using same as claimed in claim 1. Therefore, apparatus/method claims *8-13* are rejected for the same reasons of anticipation as used above.

12) Claims *2-5* are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13) The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant is reminded that in amending in response to a rejection of claims (if the rejection involves with any applicable arts), the *patentable novelty must be clearly shown* in view of the state of the art disclosed by the references cited and the objection made. Applicant must also show how the amendments *avoid* such references and objections. See 37 CFR § 1.111(c).

Form PTO-892 is attached herein.

14) Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAN XUAN DINH whose telephone number is (571)272-7586. The examiner can normally be reached on MONDAY to FRIDAY from 8:00AM to 5:30PM.

The FAX phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov/. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TAN DINH
PRIMARY EXAMINER
February 7, 2007